



PATENT  
3672-0109P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: EBBESEN et al. Conf.: 6979  
Appl. No.: 09/720,084 Group: 2877  
Filed: December 20, 2000 Examiner: KIANI, K.C.

For: APPARATUS COMPRISING ELECTRONIC AND/OR OPTOELECTRONIC  
CIRCUITRY AND METHOD FOR REALIZING SAID CIRCUITRY

LARGE ENTITY TRANSMITTAL FORM

Assistant Commissioner for Patents  
Washington, DC 20231

March 11, 2003

Sir:

Transmitted herewith is a Reply to Restriction/Election  
Requirement in the above-identified application.

- ☐ The enclosed document is being transmitted via the  
Certificate of Mailing provisions of 37 C.F.R. § 1.8.
- ☐ Petition for ( ) month(s) extension of time pursuant  
to 37 C.F.R. §§ 1.17 and 1.136(a). \$0.00 for the extension  
of time.
- ☒ No fee is required.
- ☐ A check in the amount of \$0.00 is enclosed.
- ☐ Please charge Deposit Account No. 02-2448 in the amount of  
\$0.00. A triplicate copy of this sheet is attached.

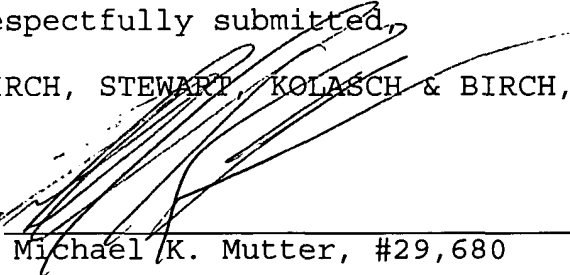
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

  
Michael K. Mutter, #29,680

  
MKM/JPK/kmr  
3672-0109P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

Attachment(s)

(Rev. 09/19/02)



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For: APPARATUS COMPRISING ELECTRONIC AND/OR  
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**REPLY TO RESTRICTION/ELECTION OF SPECIES REQUIREMENT**

Assistant Commissioner for Patents  
Washington, DC 20231

March 11, 2003

Sir:

In reply to the Restriction Requirement dated February 11, 2003, the following remarks are respectfully submitted in connection with the above-identified application.

The Examiner has required election in the present application between:

Group I, claim 1; or Group II, claim 35, and Group III, claim 43. The Examiner has also required an election of a single disclosed species. The Examiner has stated that at least claims 39-42 are generic for independent claims 35 (Group II) and 43 (Group III). For the purpose of examination of the present application, **Applicants elect with traverse, Group II, claim 35 that also includes dependent claims 2-34 and 36-42.** Additionally, Applicants elect the species identified with Group A and identify claims 2-4, 8-25<sup>1</sup>, 27-31, 34-42 as reading thereon. Consequently, claims 2-4, 8-25, 27-31, and 34-42 should be examined if this election is not reconsidered as requested herein.

***Response of 21 January 2003***

The Examiner has failed to indicate acknowledgement of the Amendment of January 21, 2003. Applicants request that the Examiner indicate acknowledgement and entrance of the January 21, 2003 Amendment and the content therein.

***IDS Issue***

The Examiner has failed to indicate consideration of the Information Disclosure Statement filed May 15, 2001. Accordingly, Applicants respectfully request that the Examiner return an initialed PTO-1449 indicating that the previously filed Information Disclosure Statement of May 15, 2001 has been considered.

***Election/Restriction Requirement***

Applicants respectfully traverse the restriction and election requirement.

To support his requirement, the Examiner relies on M.P.E.P. § 806.05(g), which, in relevant part states:

An apparatus and a product made by the apparatus can be shown to be distinct inventions if either or both of the following can be shown: (A) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus as claimed can be used to make other and different products;... (M.P.E.P. § 806.05(g))(emphasis added).

Applicants direct the Examiners' attention to independent claims 1, 35, and 43. Claims 1 and 35 are product claims and claim 43 is a method claim. The claims of the present application do not contain any claims directed to an apparatus for making a product. Since no apparatus claims for making a product is presented, The Examiner has relied on a section of the M.P.E.P. which is totally inapplicable as justification of finding Groups I, II, and III to be distinct. In fact, the Examiner has failed to even allege any reason

to support the restriction of Groups I and II from each other. Clearly, at least these "groups" should be examined together.

Additionally the Examiner has required an election of species corresponding to Groups (A), (B), and (C). The Examiner's requirement does not follow a normal accepted manner to identify species and is difficult for the undersigned to understand.

The Examiner has also failed to meet his burden with respect to restriction of the method claims from the product claims. In the absence of a showing from the Examiner, these groups are *prima facie* examinable together.

Therefore, reconsideration and examination of all claims together is requested or in the alternative examination of all product claims together, claims 1-42 and 51-54 as a single group.

### ***Conclusion***

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

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